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Conf. No. 2764Patent Application
Attorney Docket No. GEMS8081.115**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Toth et al.
Serial No. : 10/063,420
Filing Date : 4/22/2002
For : Method and Apparatus of Modulating Radiation
Filtering During Radiographic Imaging
Group Art No. : 3737
Examiner : Ramirez, John F.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

Mailing☐ deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**37 CFR 1.8(a)****37 CFR 1.10**☐ with sufficient postage as first class mail ☐ As "Express Mail Post Office to Addressee" Mailing Label No.**Transmission**☒ transmitted by facsimile to Fax No.: 571-273-8300 addressed to Director Frederick R. Schmidt at the Patent and Trademark Office.Date: July 3, 2008/Robyn L. Templin/
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RENEWED PETITION UNDER 37 C.F.R. §1.181 SEEKING SUPERVISORY REVIEW
OF REQUIREMENT FOR INFORMATION**

Dear Sir:

Responsive to the Decision on Petition mailed November 21, 2007, Applicant requests reconsideration of the Decision as that Decision is legally deficient. Applicant respectfully requests consideration of the following Remarks set forth below:

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REMARKS

In the Office Communication mailed June 7, 2006, the Examiner imposed a Requirement for Information under 37 CFR §1.105. Therein, the Examiner directed Applicant to disclose all co-pending applications and related patents that may be related to the current application and identify specific claims of those applications and/or patents that may present double patenting issues with the instant application claims. In the reply dated September 7, 2006, Applicant listed those co-pending applications and patents believed to be relevant to examination of the current application; however, Applicant stated that the additional request to identify claims that may present double patenting issues was improper as it was a request for analysis and legal conclusion, which exceeds the breadth of a Request for Information as outlined in 37 CFR §1.105.

In response to Applicant's reply objecting to the scope of the Requirement for Information, the Examiner mailed a series of Notices of Non-Compliant Amendment under 37 CFR §1.121, stating that the responses were non-compliant because Applicant objected to and did not identify specific claims of those applications or patents which may present double patenting issues with the instant application claims. Therefore, Applicant filed a Petition for Supervisory Review of the Requirement for Information on May 11, 2007, stating that (1) the Examiner's use of a Notice of Non-Compliant Amendment under 37 CFR §1.121, was improper and that (2) the replies, were fully responsive to a proper Requirement for Information under the guidelines set forth for such a requirement in MPEP §704.11, and Applicant explained why the Examiner's broad request made in the Requirement for Information was not consistent with the scope of 37 CFR §1.105.

A Decision on Petition was rendered on November 21, 2007, dismissing Applicant's petition. For the reasons set forth herein, Applicant respectfully requests reconsideration of the previous Decision on Petition based on legal error and review of the imposed Requirement for Information under the guidelines set forth for such a requirement in the MPEP.

I. The Imposed Requirement for Information

In the Requirement for Information under 37 CFR §1.105 of June 7, 2006, the Examiner directed Applicant to disclose all co-pending applications and related patents that may be related to the current application. Responsive thereto, reasonable inquiries were made to those responsible under 37 CFR §1.56(c) and to the assignee of the present application, and a list was

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provided of those co-pending applications and patents believed to be relevant to examination of the current application.

The Examiner also directed Applicant to "identify the specific claims of those [related] applications and/or patents which may present double patenting issues with the instant application claims." *Office Action*, June 7, 2006, p. 2. As set forth in MPEP §804, a double patenting rejection can be based either on statutory grounds or nonstatutory grounds. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s) in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3). MPEP §804 further states that "the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966)," in which the inquiries for determining obviousness include: (A) determining the scope and content of a patent claim relative to a claim in the application at issue; (B) determining the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue; (C) determining the level of ordinary skill in the pertinent art; and (D) evaluating any objective indicia of nonobviousness.

Applicant respectfully believes that imposing a requirement on a patent applicant to identify specific claims of related applications and/or patents which may present double patenting issues is not proper and is overlybroad under current rules. A careful examination of 37 CFR 1.105 reveals the purpose of Requirements for Information and the limits to a proper Requirement for Information. As set forth in 37 CFR §1.105, "[r]equirements for factual information known to applicant may be presented in any appropriate manner..." (emphasis added). That is, as set forth in MPEP §704.11, "[t]he terms 'factual' and 'facts' are included in 37 CFR §1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that *requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.*" MPEP §704.11 (emphasis added). From this, it is abundantly clear that any Requirement for Information under 37 CFR §1.105 should only seek to obtain facts from an applicant, not opinions. The requirement imposed on Applicant by the Examiner to identify specific claims of those applications or patents which may present double patenting issues with the instant

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application claims, is clearly requesting an opinion and is therefore contrary to the very specific rule set forth in MPEP §704.11. That is, the requirement that Applicant determine the scope and content of patent claims in the present application relative to claims in any related applications and determine the differences between the scope and content of the patent claim (per the *Graham* inquiries) is clearly requesting an opinion and is therefore contrary to MPEP §704.11.

In fact, MPEP §704.11(a) lists examples of information reasonably required to be provided by an applicant. At most, subsection (G) is most closely relevant to this issue, which states that information required for examination may include “[i]dentification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application.” MPEP §704.11(a)(G). Applicant has so complied. MPEP §704.11(a) does not authorize an examiner to require an applicant to formulate opinions on potential double patenting claims in those related applications and/or patents. MPEP §704.11 actually restricts an examiner from requiring an Applicant to formulate such opinions by specifically specifying “*requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.*” MPEP §704.11.

II. Office’s Decision on Petition

Responsive to Applicant’s Petition filed May 11, 2007, the Office cited the Federal Court decision of *Star Fruits S.N.C. v. United States*, 393 F.3d 1277 (Fed. Cir. 2005) in dismissing the Petition. In refuting Applicant’s arguments, the Office asserted that (1) the Examiner’s requirement under 37 CFR §1.105 that Applicant identify claims that may present double patenting issues is a request for factual information, not an opinion, and (2) that even were the Examiner’s requirement under 37 CFR §1.105 that Applicant identify claims that may present double patenting issues be considered requesting an opinion, that based on the holding in *Star Fruits*, “[o]pinion is clearly permitted to the extent it may define viable information.” See *Decision on Petition*, November 21, 2007, p. 3-4. Such is not the case. Neither 37 CFR §1.105 or *Star Fruits* can be read so broadly. Such a broad interpretation of *Star Fruits* would be in direct contradiction to MPEP §704.11. Applicant requests review of the following two assertions relied upon in the Office’s Decision:

- A.) “Identifying Claims that may Present Double Patenting Issues is Factual Information”; and

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B.) "Requiring Applicant to Provide Opinions is Clearly Permitted"

A. "Identifying Claims that may Present Double Patenting Issues is Factual Information"

As set forth above, in the Decision on Petition issued November 21, 2008, the Office asserted that the Examiner's requirement that Applicant identify claims that may present double patenting issues is a request for factual information, not an opinion. The Office stated that:

If an applicant were required to make an admission that the claims of one application or patent read on the claims of another, it would appear that this would be beyond the scope of 37 CFR §1.105. However, in the present situation, Applicants are not being asked this but to identify claims that may present double patenting issues. Applicants would be making comparisons to identify similarities in the claims. This is not an admission that the claims conflict. [The] Examiner still will determine this. Applicants would be identifying observed facts and then Examiner would render an opinion from these facts. Thus, an opinion from Applicants is not being required.

Decision on Petition, supra at 3 (emphasis added). Applicant respectfully disagrees as the cited paragraph reflects that Applicant would indeed have to formulate an opinion, regardless of the pronouncement that it would not. By its very definition, the requirement by the Examiner that Applicant "identify claims that may present double patenting issues" is requesting formulation of an opinion. That is, the term "may" implies that Applicant must make a determination as to what claims could or could not present double patenting issues, thus clearly requiring Applicant to formulate an opinion as to whether each claim could present double patenting issues. The very act of comparing claims (i.e., comparing claim scope) is a legal determination. It is the act of formulating an opinion to whether the scope of a claim overlaps the scope of another. Such formulation is a mental process involving a "view, judgment, or appraisal" formed in Applicant's mind as to whether the scope of our claim overlaps the scope of another, which is the very definition of an opinion.¹ Contrary to the Office's assertion, the present Requirement for Information is not simply asking Applicant to "identify" factual information. As identified by the Office in the Decision, to identify claims that may present double patenting issues requires a preliminary step of "mak[ing] comparisons to identify similarities in claims." *Decision on Petition*, supra at 3. It is this comparison that requires formulation of an opinion, as defined by the Office's own definition of double patenting in the MPEP.

¹ See Merriam-Webster Online Dictionary at <http://www.merriam-webster.com/dictionary/opinion>.

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In fact, the Examiner's requirement under 37 CFR §1.105 goes well beyond mere identification of claims, but requires Applicant to analyze the elements of specific claims and make a determination (i.e., formulate an opinion) as to whether a double patenting rejection might be appropriate – this is a legal determination. That is, identifying claims that may present double patenting issues requires Applicant to analyze the elements of each claim in the present application and the related applications, make a comparison between the elements of those claims, and opine on what claims may present double patenting issues. Requiring Applicant to perform these tasks clearly goes beyond a mere “request for factual information” that is allowed under and 37 CFR §1.105 and requires Applicant to formulate an opinion in direct contradiction to the directive set forth in MPEP §704.11.

Applicant also objects to the Office's characterization of the Requirement as not requiring Applicant to make “an admission that the claims conflict.” *Decision on Petition*, supra at 3. The Office stated that “[i]f an applicant were required to make an admission that the claims of one application or patent read on the claims of another, it would appear that this would be beyond the scope of 37 CFR §1.105” (*id.* at 3), but that such was not the case with respect to the requirement imposed by the Examiner. Applicant disagrees. The requirement under 37 CFR §1.105 imposed by the Examiner, that Applicant identify claims that may present double patenting issues, is in effect requiring Applicant to make a tacit admission that the claims should be rejected under a double patenting analysis. The Office cannot reasonably assert that such an analysis and identification of claims by Applicant is “not an admission that the claims conflict,” as the identification of claims by Applicant would clearly influence a determination by the Examiner in setting forth any future double patenting rejections. Does the Office believe that Applicant could reasonably assert that a certain claim “could” be subject to double patenting, then when the Examiner issues the double patenting rejection, allow Applicant to then argue they are not?

Essentially, a requirement imposed by the Examiner on the Applicant to identify claims that may raise double patenting issues is no different than a requirement that Applicant identify claims that may be anticipated or obvious by any particular reference. According to the rationale set forth by the Examiner, such a requirement would also be proper under 37 CFR §1.105, as Applicant would not be making an “admission” that the claims are anticipated or obvious, but would only be identifying claims that may be anticipated or obvious by that reference, with the final determination to be made by the Examiner. The clear absurdity of this scenario emphasizes the opinion being requested from Applicant with regard to an obvious-type double patenting

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rejection. Such a requirement could not be reasonably supported under 37 CFR §1.105, and as the present Requirement for Information is similar to such a requirement, the present Requirement for Information also cannot be said to be supported under 37 CFR §1.105.

Directing Applicant to analyze the claims in the manner set forth by the challenged Requirement to identify claims that may present double patenting issues, is clearly outside the intended scope of the Requirement for Information under 37 CFR §1.105. Such a requirement places the Examiner's burden on the Applicant to make an initial analysis and determination as to whether the claims should be rejected under non-statutory double patenting. While such a requirement may be allowed under pending legislation, it clearly falls outside the scope of the current version of 37 CFR §1.105 and MPEP §704.11. The very fact that the Decision states that Applicant is merely identifying facts, and "then the Examiner would render an opinion from these facts" dictates that Applicant is indeed being asked to render its opinion first and -- in essence, perform the Examiner's job for him/her. The Examiner then will agree or disagree with Applicant, but both will have formulated opinions.

B. "Requiring Applicant to Provide Opinions is Clearly Permitted"

In dismissing Applicant's Petition, the Office also stated that "it *appears* that the Court considers forms of opinion relevant and within the authority of the Examiner to require" and cited to the decision in *Star Fruits* for supporting the assertion. *Decision on Petition*, supra at 3 (emphasis added). Even though MPEP specifically forbids request for opinion, the Office stated that:

Opinion is clearly permitted to the extent it may define viable information. This is not different from an applicant citing a reference for consideration before the examiner, as this is an opinion as to what is believed material to patentability under 37 CFR §1.56. The examiner considers that reference and ultimately determines whether that reference is to be applied against the claims. When the examiner requires a submission of information under 37 CFR §1.105 that may be material to patentability, the examiner is still making the ultimate decision based on the submission whether that material is applicable. The examiner has required this information because it "improve[s] patent quality, and render[s] better decisions" (MPEP 704.11).

Id. at 4. The Office reliance on *Star Fruits* is misplaced.

The issue before the court in *Star Fruits* was whether the appellants therein were within their rights to refuse providing facts requested by the Examiner under 37 CFR §1.105. Specifically, the Examiner in *Star Fruits* requested that appellants provide "information available

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regarding the sale or other public distribution of the claimed plant variety anywhere in the world.” *Star Fruits*, supra at 1280. This request was for factual information and clearly falls under the scope of 37 CFR §1.105, as MPEP §704.11(a)((S)(9) sets forth that “facts related to public use or sale situations” may be properly requested by the Examiner. The Examiner’s Requirement for Information in *Star Fruits* was proper because it clearly requested nothing more than factual information. That requirement is akin to the Examiner’s request to identify patents and patent applications that would be relevant to double patenting. However, had the Requirement in *Star Fruits* asked the Applicant to identify claims that may be unpatentable in light of the public use or sale situation, that request would have gone beyond the scope of 37 CFR §105 as that request would have requested opinion, versus just facts.

The present Requirement for Information under 37 CFR §1.105 is clearly distinct from the Requirement for Information set forth in *Star Fruits*. That is, the present Requirement demands that Applicant identify specific claims that may present double patenting issues that would be akin to requesting *Star Fruits* to identify unpatentable claims and clearly falls outside the bounds of 37 CFR §1.105 and MPEP §704.11.

As set forth above, the requirement that Applicant identify claims that may present double patenting issues is actually requiring Applicant to formulate an opinion as to the patentability of certain claims. Nowhere in MPEP 37 CFR §1.105, MPEP §704.11, or MPEP §704.11(a) is such a requirement set forth as an example of information that is “reasonably required” or “reasonably necessary.” In fact, as set forth in MPEP §704.11, “[t]he terms ‘factual’ and ‘facts’ are included in 37 CFR §1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that *requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.*” MPEP §704.11 (emphasis added).

The Office’s assertion that “[o]pinion is clearly permitted to the extent it may define viable information” is in direct contradiction to the purpose of 37 CFR §1.105, as set forth in MPEP §704.11. Had the legislators desired the “Requirement for Information” to impel Applicants to formulate opinions on matters related to patentability, they would have included such language in 37 CFR §1.105. The Office knows it did not when it formulated MPEP §704.11 stating: “*requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.*” MPEP §704.11 (emphasis added).

Additionally, nowhere in the decision by the Court in *Star Fruits* is it set forth that an examiner may appropriately require an Applicant to formulate an opinion under 37 CFR §1.105.

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While the Court in *Star Fruits* held that the Office is authorized under section 37 CFR §1.105 to require information that is “reasonably necessary to properly examine or treat the matter,” the Court also qualified that statement by stating that the Office cannot simply interpret and enforce its own regulations in any desired manner if the interpretation and enforcement of those regulations is “plainly erroneous or inconsistent with the regulation.” *Star Fruits*, supra at 1282.

In the present case, the Examiner’s “Requirement for Information” is clearly erroneous in that it is inconsistent with the scope of the “Requirement for Information” set forth in 37 CFR §1.105 and directly contradicting to MPEP §704.11. Both 37 CFR §1.105 and MPEP §704.11 set forth that it is factual information that should be requested, and that requiring an Applicant to formulate opinions is not within the scope of a request made by the Examiner under 37 CFR §1.105. Thus, the Requirement for Information presently set forth by the Examiner is clearly differentiated from the requirement under 37 CFR §1.105 at issue in *Star Fruits*. The Office’s statement that “it appears that the Court considers forms of opinion relevant and within the authority of the Examiner to require” is a clear misstatement of the law, as it has no basis or support in the *Star Fruits* decision or in 37 CFR §1.105, MPEP §704.11, or MPEP §704.11(a).

In sum, the Office has not provided a valid basis for requiring Applicant to identify specific claims in the applications and/or patents identified by Applicant which may present double patenting issues with the instant application claims. The Requirement is improper and, in fact, is contradictory to the scope of a Requirement for Information under 37 CFR §1.105 and MPEP §704.11.

III. Examiner’s Improper Use of Notice of Non-Compliant Amendment Under 37 CFR 1.121

Applicant respectfully believes that the Examiner’s use of a Notice of Non-Compliant Amendment under 37 CFR 1.121, regarding the reply filed on September 7, 2006, is also improper. While Applicant objected in part to the Requirement for Information imposed by the Examiner, no amendments were made to the current application in that response. Accordingly, the use of a Notice of Non-Compliant Amendment under 37 CFR 1.121 is clearly improper. 37 CFR 1.121 is entitled “Manner of making amendments in applications” and sets forth rules governing the proper form and procedure for submitting amendments to an application. It provides information on the proper manner to, and stylistic rules for, *amending* an application. Since Applicant made no amendments, the Notice is deficient on its face and clearly departs from 37 CFR 1.121.

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Furthermore, MPEP §714 sets forth when it is proper for an Examiner to send a Notice of Non-Compliant Amendment under 37 CFR 1.121 to an Applicant. MPEP §714 states that “[i]f an amendment... fails to comply with 37 CFR 1.121, the Office will notify applicant by a Notice of Non-Compliant Amendment, Form PTOL-324, that the amendment fails to comply with the requirements of 37 CFR 1.121...” *MPEP §714(II)(F)* (emphasis added). Therefore, per MPEP §714(II)(F), a Notice of Non-Compliant Amendment should only be prepared when there is an amendment that fails to comply with 37 CFR 1.121. No amendments were made in the response of September 7, 2006, and as such, the Examiner has provided no grounds for the issuance of a Notice of Non-Compliant Amendment under 37 CFR 1.121.

Summary

For all these reasons, Applicant believes that the reply previously filed on September 7, 2006, is fully responsive to the Requirement for Information under 37 CFR §1.105.

In summary, the Examiner has no basis in either the CFR, the MPEP, or from *Star Fruits* for the continued requirement that Applicant identify specific claims which may present double patenting issues with the instant application claims. Applicant thus believes that the Responses previously submitted were, in fact, proper responses to the requirement under 37 CFR §1.105.

Applicant believes no fee is due for filing the Renewed Petition; however, should a fee be deemed necessary, Applicant hereby authorizes charging of Deposit Account No. 07-0845.

Applicant appreciates the Office's consideration of these Remarks and cordially invites the Office to call the undersigned to expedite resolution of these matters.

Respectfully submitted,

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